

## REMARKS

Applicants previously presented claims 82-115 for examination. In the above-identified Office Action, all of the claims were rejected.

Applicants appreciate the Examiner's detailed comments in his Office Action to the above-identified application. Because of the care that the Examiner has exhibited in his Office Action, Applicants have been able to fully appreciate and understand the Examiner's reasons and grounds for the rejections. For the reasons to be stated below, however, Applicants respectfully traverse the Examiner's rejections.

Applicants also appreciate Special Program Examiner Linda Sholl in explaining to Applicants' representative, rules and practices in the area of reissue, through a telephone interview on August 9, 2005, and have incorporated her suggestions accordingly.

By this amendment, Applicants have included new declarations and have modified the claim numbering so that the numbering starts from claim 21<sup>1</sup>, since the highest claim number of the US Patent 6,160,987 is 20. With the claim numbers in the Office Action being based on the pre-amended claim numbers, Applicants have included the following table to help clarify claim numbering, with "Old" being the pre-amended claim number and "New" being the amended claim number:

Old	New	Old	New	Old	New	Old	New	Old	New	Old	New	Old	New
82	21	83	22	84	23	85	24	86	25	87	26	88	27
89	28	90	29	91	30	92	31	93	32	94	33	95	34
96	35	97	36	98	37	99	38	100	39	101	40	102	41
103	42	104	43	105	44	106	45	107	46	108	47	109	48
110	49	111	50	112	51	113	52	114	53	115	54		

This Remarks section is still based on the old claim numbers. However, for clarification reasons, next to each old claim number, Applicants have included the new claim number.

At the end of the Remarks, Applicants have included a supplemental paper under 37 CFR 1.173(c) indicating the status of all patent claims and an explanation of the support in the disclosure of the patent for the changes made to the claims. Also, Applicants have amended claim 82(21), 89(28), 92(31), 94(33), 97(36) - 101(40),

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<sup>1</sup> 37 CFR 1.173(e)

108(47), and 114(53), to further clarify the subject matter regarded as the invention, and have added new claim 55. Since all the claims are underlined, Applicants have included the following table to show the claim amendments Applicants made in this response.

	Before Amendment	After Amendment
82 (21) and 92 (31)	setting a time for a group of users to start a dialogue session to work on materials related to the subject so as to provide an interactive environment to help the users learn;	setting a time for a group of users to start a dialogue session to work on materials related to the subject so as to provide an interactive environment, <u>through at least a plurality of electronic devices, each being able to at least receive inputs from a user,</u> to help the users learn;
	retrieving materials related to the subject during the dialog session for the group of users	retrieving materials related to the subject during the dialog session for <u>each of the users in</u> the group of users
89 (28)	A computer-implemented group-learning method as recited in claim 21 further comprising, allowing materials related to the subject to be provided to just one user, to allow the user to learn.	A computer-implemented group-learning method as recited in claim 21 further comprising, <del>allowing materials related to the subject to be provided to just one user</del> <u>providing, during the session, materials related to the subject to just one user,</u> to allow the user to learn.
94 (33)	... separate from at least one other user.	... separate from at least one other user, <u>and among the some of the users, allowing one user to transmit materials to the other users, with the materials available to be received by the other users during the session.</u>
97 (36)	retrieving materials related to the subject for a user	retrieving materials related to the subject for a user <u>during the session</u>
97 (36) to	allowing a group of users to engage in a dialogue session while working	allowing a group of users to engage in a dialogue session while working on the

101 (40) and 108 (47)	on the subject, with the session providing an interactive environment for the users to learn;	subject, with the session providing an interactive environment, <u>through at least a plurality of electronic devices, each being able to at least receive inputs from a user,</u> for the users to learn;
100 (39)	materials on a problem regarding the subject can be sent to the users to allow them to work on the problem	materials on a problem regarding the subject can be sent to <u>each of</u> the users to allow them to work on the problem
108 (47)	allowing materials on a problem regarding the subject to be sent to the users during the session so that they can work on the problem	allowing materials on a problem regarding the subject to be sent to <u>each of</u> the users during the session so that they can work on the problem
114 (53)	comprising assessing the user during the session to customize the training of the user	comprising assessing <del>the</del> <u>that</u> user during the session to customize the training of the user

Accordingly, claims 82 (21) – 115 (54) and claim 55 remain pending. Applicants respectfully request that the Examiner reconsider the application in light of the amendments and the remarks expressed herein.

#### Paragraph 2 of the Office Action on Defective Declaration

In its paragraph 2, the Office Action asserted that the “reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414)” because the “error which is relied upon to support the reissue application is not an error upon which a reissue can be based.”

According to MPEP 1414.II.(D), where a continuation reissue application is filed with a copy of the reissue declaration from the parent reissue application that is not to be abandoned, the Examiner should require a new declaration. Accordingly, Applicants are submitting new declarations herewith.

In the newly-submitted declarations, Applicants state that claim 1 recites the limitation of “to guide at least one user back to the subject in the dialogue session when

one or more users have been distracted from the subject”, but the invention does not require “to guide at least one user back to the subject in the dialogue session when one or more users have been distracted from the subject”, thus the limitations are unnecessary limitations to the invention.

Since the error which is relied upon to support this reissue application is an error upon which a reissue can be based, Applicants respectfully submit that the reissue declarations filed with this office action response are not defective.

#### Paragraph 2 of the Office Action on Offer to Surrender the Original Patent

In its paragraph 2, the Office Action further asserted that the reissue application was filed without the required offer to surrender the original patent. However, due to rule changes, Applicants are no longer required to surrender the original patent. Also, Applicants have already offered to surrender the original patent in the parent reissue application. Thus, the original patent is inaccessible.

In view of changes in the rules, and in view of the original patent already being surrendered and inaccessible by Applicants, Applicants respectfully submit that further offer to surrender is not necessary before this reissue application can be allowed.<sup>2</sup>

#### Paragraph 3 of the Office Action

In its paragraph 3, the Office Action rejected claims 82(21) - 115(54) “under 35 U.S.C. 251 as being enlarging the scope of the claims of the original patent in a reissue application filed outside the two years statutory period.” Applicants respectfully disagree.

This continuation reissue application was filed on December 5, 2003. Its parent application with serial number 10/264,552, was filed on October 6, 2002, which was subsequently issued as RE38,432 on February 24, 2004. The parent application 10/264,552 was a reissue application of US Patent 6,160,987, which was issued on December 12, 2000.

According to MPEP 1412.03, “if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing

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<sup>2</sup> See, for example, 37 CFR 1.178 or MPEP 1416.

reissue application after the two year period.” Claim broadening is allowed in this continuation application because (a) the parent reissue application was filed within the two year statutory period, (b) the parent reissue was a broadening reissue application, and (c) this continuation application was submitted during the pending period of the parent reissue application. Thus, Applicants respectfully request withdrawing the above rejection under 35 U.S.C. 251.

The Office Action further asserted that Applicants correcting errors arose on claim 1 of the original patent were improper because “all the claims of the original patent are cancelled and not amended; hence the error does not exist.” Applicants respectfully disagree.

“Following the decision in *Graff* [*In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997)], the Office has adopted a policy of treating continuations and divisionals of reissue applications, to the extent possible, in the same manner as continuations and divisionals of non-reissue applications.”<sup>3</sup> “Where the parent reissue application issues prior to the examination of the continuation, the claims of the continuation should be carefully reviewed for double patenting over the claims of the parent.”<sup>4</sup> Applicants are required to cancel claim 1 in this continuation reissue application. Otherwise, there would have been a double-patenting error. Thus, Applicants respectfully submit that Applicants correcting errors arose on claim 1 of the original patent were proper.

In other words, claim 1 is only being canceled because claim 1 has already been reissued in RE38,432. If claim 1 were not canceled, the Examiner would be required to issue a double patenting rejection of claim 1. Nevertheless, the error of claim 1 that includes the unnecessary limitation of “to guide at least one user back to the subject in the dialogue session when one or more users have been distracted from the subject” does indeed exist.

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<sup>3</sup> MPEP 1451, first paragraph after the citations on the laws and rules.

<sup>4</sup> MPEP 1451, page 1400-64, second paragraph.

#### Paragraph 4 of the Office Action

In its paragraph 4, the Office Action identified mistakes in the manner of making amendments in reissue applications. The Office Action further suggested submitting a supplemental paper correctly amending the reissue application according to 37 CFR 1.173(b) and 1.173(c).

Following the suggestions, Applicants have submitted a supplemental paper as an appendix to this response to the Office Action. In the supplemental paper, Applicants have set forth the status of all patent claims and all added claims as of the date of this submission. Also, to prevent any possible errors under 1.173(b) and 1.173(c) in amending the reissue application, Applicants have provided examples of support in the disclosure of the patent for all the pending claims.

Based on the submission, Applicants believe they have complied with 37 C.F.R. 1.173(b) and 1.173(c). However, if the Examiner determines that there are still provisions under these sections Applicants have not complied with, Applicants respectfully request a detailed explanation of the deficiency, and a suggestion for bringing the amendments into compliance.

#### Paragraph 8 of the Office Action

In its paragraph 8, the Office Action rejected claims 97(36) and 110(49) under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over “An Update on WebCT (World-Wide-Web Course Tools) A Tool for the Creation of Sophisticated Web-Based Learning Environments” by Goldberg et al (hereinafter as “Goldberg”). Applicants respectfully disagree.

In general, Goldberg pertains to WebCT, which is a tool to facilitate the creation of Web-based educational environment for educators to design course pages, to incorporate tools into courses, and to administer courses.

#### Goldberg does not teach or suggest its tools retrieving materials related to a subject in a dialogue session

Regarding claim 97(36), the Office Action asserted that the Chat Tool in Goldberg is a dialogue session, and materials related to a subject could be retrieved

during the session based on the Student Presentation Area.<sup>5</sup> Applicants respectfully disagree.

Goldberg's Chat Tool generally describes allowing students to enter a chat room to communicate with one another. "Students in a room are able to communicate with one another in that anything any student in a room types [] seen by all occupants of that room.... Four of the course-specific rooms have all conversations logged. These logs are available to course designer. In this way the designer is able to monitor conversations ...."<sup>6</sup> As shown in the description, Goldberg's chat rooms seem to be just for chats. It is not clear where Goldberg describes any tool to perform tasks other than chats in the Chat Tool. For example, Goldberg's Chat Tool does not teach or suggest retrieving materials related to a subject for a student during chats in the chat rooms.

In an attempt to remedy the deficiency, the Office Action introduced Goldberg's Student Presentation Area. However, Goldberg's Student Presentation Area generally describes "the publication of group projects" by a group of students for the class.<sup>7</sup> Publication of group projects may allow for viewing by the students. But, publication of group projects is not a dialogue session. If the students want to have a certain degree of information exchange in the Student Presentation Areas, Goldberg generally describes using "bulletin-board."<sup>8</sup> Goldberg's bulletin-board uses icons to reflect whether there are unread messages in the bulletin board. When an icon is pressed, unread messages are displayed.<sup>9</sup> In other words, if the icon is not pressed, messages will not be displayed. This is different from students interacting in a dialogue session. And Goldberg has not taught or suggested its chat rooms having the capabilities of publishing group projects as in its Student Presentation Area.

It is unclear where Goldberg teaches or suggests in its Chat Tools the abilities of retrieving materials related to a subject for a user in the chat rooms.

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<sup>5</sup> The last line on page 4 to the second line on page 5 of the Office Action.

<sup>6</sup> The second full paragraph on page 4 of Goldberg.

<sup>7</sup> The 4<sup>th</sup> line from the bottom on page 4 of Goldberg.

<sup>8</sup> The last line on page 4 of Goldberg.

<sup>9</sup> The second to the last paragraph on page 3 of Goldberg.

Goldberg does not teach or suggest its tools allowing a user to create notes while working on the subject and allowing the user to link a piece of notes created to an area of the materials retrieved.

The Office Action acknowledged that Goldberg does not teach “allowing the user to create notes while working on the subject and allowing the user to link a piece of notes created to an area of the materials retrieved”<sup>10</sup>, which Applicants agree.

In an attempt to remedy the deficiencies, the Office Action asserted that they are obvious design choice or equivalent to “such features of clip-art of the course, the student make personal annotation for that page of notes, and once selected, a single page of content is presented showing all selected pages combined together, so as to allow students to generate their own customized study guides and simplifies printing of multiple pages of content are considered an arbitrary obvious design choice or equivalent functions as claimed, so as to provide the student a personal student guide.”<sup>11</sup> Applicants respectfully disagree. Such processes are not simple. Applicants respectfully request identifying the specific area(s) within Goldberg to support the above assertions, as required under 37 C.F.R. 1.104(C)(2).

Though not asserted in the Office Action, if the support is based on Goldberg’s Study Guide/Printing Tool<sup>12</sup>, it would also be incorrect. In Goldberg’s Study Guide/Printing Tool, Goldberg generally describes a student being able to select individual pages from a listing of paths of course content. Once selected, a single page of content is presented showing all selected pages combined together, allowing students to generate their customized study guide and simplifying printing of multiple pages of content.

In that section, Goldberg does not teach or suggest a user creating notes while working on the subject, and linking a piece of notes created to an area of the materials retrieved during the dialogue session.

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<sup>10</sup> The fifth to the seventh line from the bottom of page 5 of the Office Action.

<sup>11</sup> The 5<sup>th</sup> line from the bottom of page 5 to the 2<sup>nd</sup> line on page 6 of the Office Action.

<sup>12</sup> The 7<sup>th</sup> paragraph on page 5 of Goldberg.



Goldberg does not teach or suggest its tools allowing a user to mark the beginning and the end of a section

Again regarding claim 97(36), the Office Action acknowledged that “the teaching of Goldberg et al does not specifically disclose the steps of allowing the user to mark the beginning and the end of a certain section of the retrieve materials so that the certain section can be brought to the user based on the mark ....”<sup>13</sup> Applicants agree with the Office Action’s acknowledgement.

As explained above, in an attempt to remedy the deficiencies, the Office Action asserted that they are obvious design choice or equivalent to “such features of clip-art of the course, the student make personal annotation for that page of notes, and once selected, a single page of content is presented showing all selected pages combined together, so as to allow students to generate their own customized study guides and simplifies printing of multiple pages of content ... so as to provide the student a personal student guide.”<sup>14</sup> Again, Applicants respectfully disagree. Such process is complicated, and it is inappropriate to just make such an assertion without any supporting reference.

Though not asserted in the Office Action, if the support is based on Goldberg’s Study Guide/Printing Tool<sup>15</sup>, again it would be incorrect. As previously explained, in Goldberg’s Study Guide/Printing Tool, Goldberg generally describes a student being able to select individual pages from a listing of paths of course content. Once selected, a single page of content is presented showing all selected pages combined together, allowing students to generate their customized study guide and simplifying printing of multiple pages of content.

Selecting a page to have it included into a page of content is different from marking the beginning and the end of a certain section so that the certain section can be brought back based on the mark. Normally, a page is an area with a predefined size. In Goldberg, to select a page, generally a student identifies the page in a listing, and Goldberg’s Tool identifies the area occupied by the page. This is different from marking the beginning and the end of a certain area.

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<sup>13</sup> Lines 7-10 from the bottom of page 5 of the Office Action.

<sup>14</sup> The 5<sup>th</sup> line from the bottom of page 5 to the 2<sup>nd</sup> line on page 6 of the Office Action.

<sup>15</sup> The 7<sup>th</sup> paragraph on page 5 of Goldberg.

The ability to mark the beginning and the end of a certain area implies that the size of the certain area does not have to be predefined. Instead, the size is set by marking its beginning and its end. For example, one can mark the beginning and the end of a paragraph within a page. As another example, one can mark the beginning to be at the middle of one page and the end to be at the middle of a second page. Goldberg does not teach or suggest such capabilities.

Based on the foregoing, it is submitted that claim 97(36) is patentably distinct from Goldberg. In addition, it is submitted that its dependent claim 110(49) is also patentably distinct for at least the same reasons. Thus, Applicants respectfully request that the Examiner withdraw the rejections of claims 97(36) and 110(49) under 35 U.S.C. 102(a) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over, Goldberg.

#### Paragraph 9 of the Office Action

In its paragraph 9, the Office Action rejected claims 82(21)-85(24), 87(26)-91(30), 98(37), 100(39)-104(43), 106(45)-109(48), 111(50), 113(52) and 114(53) under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of “Enhancing teaching using the Internet Report of the Working Group on the World Wide Web as an Internet Teaching Resource” by Hartley et al (hereinafter referred to as “Hartley”).

The Office Action acknowledged that Goldberg does not teach the following<sup>16</sup>, which Applicants agree:

- allowing some of the user to interact among themselves privately, separate from at least one other user, and among the some of the user, allowing one user to transmit materials to the other users, with the materials available to be received by the other users during the session (as per claim 82 (21));
- allowing materials related to the subject to be provided to just one user, to allow the user to learn during the session (as per claim 89 (28));
- retrieving materials related to the subject for a user, but not for at least one other user, during the session (as per claim 98 (37));

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<sup>16</sup> Page 6, line 8 to page 7 line 5 of the Office Action.

- among the some of the users, allows one user to transmit materials to the other users, with the materials available to be received by the other users, among the some of the users, allows one user to transmit materials to another user, with the materials available to be received by the another user, in private, and materials on a problem regarding the subject can be sent to each of the users to allow them to work on the problem (as per claim 100(39));
- asking at least one user a question during the dialogue session, with the question not provided to at least one other user (as per claim 101(40));
- the materials retrieved related to the subject for at least one of the users is not provided to at least one other user (as per claim 102(41)); and
- retrieving materials related to the subject for a user, and not for at least one other user, during the dialogue session, to allow the user to individually work on the retrieved materials not during the dialogue session (as per claim 108(47)).

Trying to remedy the deficiency to form the 103 rejection, the Office Action introduced Hartley, asserting that the above missing features were “broadly”<sup>17</sup> disclosed in sections 2.2.3 to 2.2.5 of Hartley. Applicants respectfully disagree. It is not clear where in those sections have the above missing features been taught or suggested.

In general terms, Hartley discusses “how electronic technology such as the Internet and World Wide Web (WWW) could be used in the teaching process”<sup>18</sup>. In its section 2.2, Hartley discusses Computer Mediated Communication (CMC), which Hartley defines in its section 2.2.3 as “using Internet-based electronic communication technology that allows people to interact with each other synchronously and asynchronously”,<sup>19</sup> where CMC “can provide communication on a one-to-one (private communication), one-to-many (broadcast), and many-to-many (group discussion) basis.”<sup>20</sup>

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<sup>17</sup> Lines 6-19 on page 7 of the Office Action.

<sup>18</sup> The first paragraph on the left-hand column of page 218 in Hartley.

<sup>19</sup> The last full paragraph on the right-hand column of page 220 under 2.2.1 in Hartley.

<sup>20</sup> The first full paragraph on the left-hand column of page 221 under 2.2.3 in Hartley.

In its section 2.2.4, Hartley generally discusses one-to-one communication using asynchronous techniques, such as e-mail, for every student to have equal access to his or her instructor.<sup>21</sup>

In its section 2.2.4, Hartley generally discusses one-to-many communication with the following descriptions: (a) make group announcements asynchronously, including corrections to previous documents, answers to common questions or clarifications, with a mailing list and/or a read-only newsgroup/conference; (b) give lectures to students at a distance or replay to students locally; and (c) give live lectures for distance students or local students at a remote site.<sup>22</sup>

In its section 2.2.4, Hartley generally discusses many-to-many communication with the following descriptions: (a) provide a forum for peer interaction; (b) facilitate group project work; and (c) include enrichment topics in the curriculum (such as ethical and social issues).<sup>23</sup>

Then in its section 2.2.5, Hartley generally discusses other issues in CMC, such as: (a) the cultural expectations of members of a group; (b) some students may find technologies threatening; (c) a social change may be needed in using asynchronous text-based CMC; (d) there can be large volume of messages in asynchronous communications; (e) a framework must be provided for acceptable behavior among the group members; and (f) instructors need to take specific actions in CMC.<sup>24</sup>

It is not clear where in Hartley's sections 2.2.3 to 2.2.5 has Hartley taught or suggested any of features cited above that the Office Action acknowledged as not being taught by Goldberg. The following explains in more detail Applicants' positions in each of the rejected claims.

#### Claim 82(21)

A number of limitations in claim 82(21) are not taught or suggested by Goldberg and/or Hartley. For example, regarding the limitation of "assessing, during the session, the understanding of at least one user in an area of the subject", Hartley does not teach or

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<sup>21</sup> The second paragraph on the right-hand column of page 221 under 2.2.4 in Hartley.

<sup>22</sup> The fourth and fifth paragraphs on the right-hand column of page 221 under 2.2.4 in Hartley.

<sup>23</sup> The last paragraph on the right-hand column of page 221 under 2.2.4 in Hartley.

<sup>24</sup> Section 2.2.5 in page 222 of Harley.

suggest assessment. As to Goldberg, in paragraph 8 of the Office Action (the paragraph in the Office Action that rejected claim 97(36), instead of claim 82(21)), the Office Action asserted that the Progress Tracking in Goldberg performs the functions of “assessing the understanding of at least one user in an area of the subject”.<sup>25</sup> Applicants respectfully disagree.

Goldberg’s Progress Tracking Tool “maintains detailed information regarding accesses made by each student to a course.”<sup>26</sup> The Tool seems to be able to keep track of the date each student first accesses the course and the total number of accesses to the course. The Tool also seems to be able to show a histogram of accesses made to various course components, and students that have accessed the course more than a certain number of times and have posted more than a certain numbers of bulletin-board entries.<sup>27</sup> However, the frequency of accesses does not equate to assessing understanding. A student can access an area many times and still does not understand the area. Conversely, a student may have skipped an area because the student has previously mastered the area. Thus, Goldberg has not taught or suggested techniques to assess the understanding of a user.

One may argue that Goldberg’s Student Self Evaluation<sup>28</sup> or Goldberg’s Timed On-Line Quizzes<sup>29</sup> provides assessment. However, such evaluation or quizzes are not performed during a dialogue session, as required in the claim.

As to the limitations of “allowing some of the users to interact among themselves privately, ... and among the some of the users, allowing one user to transmit materials to the other users, with the materials available to be received by the other users during the session”, the Office Action asserted that Hartley teaches such limitations. Applicants respectfully disagree.

The Office Action has not identified where in Hartley such limitations are taught. It cannot be in Hartley’s sections on one-to-one communication, one-to-many communication and many-to-many communication. Each of these communication systems is described separately. For example, Hartley has not taught or suggested a

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<sup>25</sup> From the second to the fourth lines on page 5.

<sup>26</sup> The second to the last full paragraphs on page 5 of Goldberg.

<sup>27</sup> The third and the fourth full paragraphs on page 6 of Goldberg.

<sup>28</sup> The third full paragraph on page 4 of Goldberg.

<sup>29</sup> The third paragraph from the bottom on page 6 of Goldberg.

system that integrates these systems together. Nor has Hartley taught or suggested a system with a sub-system inside, such as allowing a private many-to-many communication for some of the users involved in a many-to-many communication.

Nowhere has Hartley taught or suggested a system or a computer-implemented method that (a) starts a dialogue session for a group of users to work on and to learn about a subject, and (b) allows some of the users (who are involved in the dialogue session) to interact among themselves privately, let alone having the system or method allow, among the some of the users, one to transmit materials to the other users, with the materials available to be received by the other users during the session.

Also, regarding the “generating a report” limitations in claim 82(21), Hartley does not teach or suggest such limitations. As to Goldberg, in paragraph 8 of the Office Action (the paragraph in the Office Action that rejected claim 97(36), instead of claim 82(21)), the Office Action asserted that Goldberg’s Questionnaire Delivery and Report, and Student Account Management and Grade Database teach Applicants’ “generating a report that includes information regarding the understanding of the at least one user in at least the area of the subject, wherein the report also can include information regarding the understanding of a number of users as a group in at least one area of the subject”.<sup>30</sup> Applicants respectfully disagree.

In the claim, Applicants assesses the understanding of the user during the dialogue session, and generates a report that includes information regarding the understanding of the user. However, Goldberg generally describes the on-line quizzes being “delivered on-line on a predetermined day.”<sup>31</sup> Such quizzes are not delivered during Goldberg’s Chat Tool, which the Office Action identified as the dialogue session. Nowhere in Goldberg’s Chat Tool has Goldberg described administering quizzes to the students. With Goldberg not teaching or suggesting Applicants’ assessing during the dialogue session the understanding of a user, Goldberg could not have taught or suggested generating a report that includes information regarding the understanding of the user.

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<sup>30</sup> Lines 9-12 on page 5 of the Office Action.

<sup>31</sup> The sixth paragraph on page 6 of Goldberg.

Thus, Applicants submit that both Goldberg and Hartley, singly or in any combination, do not teach or suggest Applicants' invention as claimed in claim 82(21).

Claim 89(28)

Regarding claim 89(28), though acknowledged as not taught in Goldberg, the Office Action asserted that the limitations are taught in Hartley. First, claim 89(28) depends on claim 82(21). With Hartley not teaching or suggesting claim 82 (21), Hartley could not have taught or suggested claim 89(28).

Moreover, Hartley has not taught or suggested providing, during the dialogue session, materials related to the subject to just one user, to allow the user to learn. The Office Action has not identified where in Hartley such limitations are taught.

Hartley's one-to-many and many-to-many communication generally describe communication mode involving many students, not just one student.

Hartley's one-to-one communication generally describes a communication mode allowing one person to communicate with another person, such as through e-mail. In Hartley's one-to-one communication mode, it is a person communicating with another person, such as through e-mail. This is distinctly different from what is claimed under claim 89(28) where (a) it is during the dialogue session that materials are provided to just one user, (b) it is the computer-implemented method that is providing the materials related to the subject to allow the user to learn, not a person sending an e-mail to another person, and (c) materials are just provided to one user, not to other users during the dialogue session.

Thus, Applicants submit that both Goldberg and Hartley, singly or in any combination, do not teach or suggest Applicants' invention as claimed in claim 89(28).

Claim 98(37)

No teachings or suggestions of "retrieving materials related to the subject for a user, but not for at least one other user, during a dialogue session"

Regarding claim 98(37), not only that Goldberg has not taught or suggested “retrieving materials related to the subject for a user, but not for at least one other user, during a dialogue session”<sup>32</sup>, Hartley also has not taught or suggested such features.

The Office Action just asserted that Hartley teaches such features, but has not identified where in Hartley such features are recited. Hartley’s one-to-many and many-to-many communication do not discriminate who will get the communication. As to Hartley’s one-to-one communication mode, it is a person communicating with another person, such as through e-mail. This is distinctly different from what is claimed under claim 98(37) where (a) it is during the dialogue session that materials are retrieved for a user, (b) it is the computer-implemented method that is retrieving the materials related to the subject for a user, not a person sending an e-mail to another person, and (c) materials are retrieved for a user, but not for at least one other user during the dialogue session.

No teachings or suggestions of “allowing the user to extract a portion of the retrieved materials and add the portion to the user’s notes”

As to the limitations of “allowing the user to extract a portion of the retrieved materials and add the portion to the user’s notes”, in paragraph 8 of the Office Action (the paragraph in the Office Action for claim 97(36), instead of claim 98(37)), the Office Action asserted that Goldberg’s “Indexing and Searching, Page Annotation, Page References, Searchable Image Archive, and Course Backup, Restore and Transport Facility” provide such teachings. Applicants respectfully disagree.

Goldberg’s Indexing and Searching seems to allow “the creation of an index of course content and terms”<sup>33</sup>, and the course content to “be searched”.<sup>34</sup> There is no reference here to extracting retrieved materials and adding to the user’s notes.

Goldberg’s Page Annotation generally describes allowing the course designer to add a button to any page of path content. A student can click the button “to make personal annotations for that page of notes”.<sup>35</sup> Allowing a student to make personal

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<sup>32</sup> This is acknowledged on page 6 of the Office Action.

<sup>33</sup> The second paragraph on page 5 of Goldberg.

<sup>34</sup> The second paragraph on page 5 of Goldberg.

<sup>35</sup> The third paragraph on page 5 of Goldberg.



annotations is distinctly different from allowing the user to extract a portion of the materials retrieved during the dialogue session, and add the portion to the user's notes.

Goldberg's Page References generally describe allowing a course designer (not students or the users learning a subject through a dialogue session) to associate a reference, such as papers, textbooks and URLs, with any page of content on a learning path.<sup>36</sup> It is incorrect to equate Goldberg's associating a reference with a page of content to Applicants' claimed invention because the course designer is not the one working on and learning about a subject in a dialogue session. Also, the materials used by the designer are not extractions from materials retrieved during the dialogue session.

Goldberg's Searchable Image Archive generally describes allowing students to search for images based on annotations associated with each image made by a designer.<sup>37</sup> Note again that the annotations associated with images in Goldberg are made by a course designer (not students or the users learning a subject through a dialogue session).

Goldberg's Course Backup, Restore and Transport Facility seem to be administrative tools allowing a course designer (not students or users learning a subject through a dialogue session) to backup a course in the designer's computer so that the course can be restored and moved from one server to another.<sup>38</sup> This does not seem to be relevant to extracting a portion of the materials retrieved during the dialogue session and adding the portion to the user's notes.

None of the above tools described in Goldberg teaches or suggests the limitation of "allowing the user to extract a portion of the retrieved materials and add the portion to the user's notes", particularly when the retrieved materials are (a) related to the subject, (b) retrieved for one, but not another user, and (c) retrieved during a dialogue session.

Thus, Applicants submit that Goldberg and/or Hartley do not teach or suggest, singly or in any combination, Applicants' claim 98(37).

#### Claim 100(39)

Regarding claim 100(39), based on explanations similar to those above under claim 82(21), both Goldberg and Hartley, singly or in any combination, do not teach or

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<sup>36</sup> The fourth paragraph on page 5 of Goldberg.

<sup>37</sup> The fourth paragraph from the bottom on page 4 of Goldberg.

<sup>38</sup> The last full paragraph on page 7 of Goldberg.

suggest “allowing some of the users (from a group of users in a dialogue session), which can be more than two, to engage in a separate dialogue privately among themselves, apart from at least one other user, such that during such dialogue, among the some of the users, allows one user to transmit materials to the other users, with the materials available to be received by the other users”. In addition, Goldberg and Hartley, singly or in any combination, do not teach or suggest that during such a separate dialogue, “among the some of the users, allows one user to transmit materials to another user, with the materials available to be received by the another user, in private, and materials on a problem regarding the subject can be sent to each of the users to allow them to work on the problem”. Nowhere in Goldberg and/or Hartley do they have discussions regarding a separate dialogue in a dialogue session, let alone the separate dialogue having so many features as recited in claim 100(39).

Thus, Applicants submit that Goldberg and/or Hartley do not teach or suggest, singly or in any combination, Applicants’ claim 100(39).

#### Claim 101(40)

Regarding claim 101(40), not only that Goldberg has not taught or suggested a computer-implemented group-learning method “asking at least one user a question (during a dialogue session for a group of users working on and learning about a subject), with the question not provided to at least one other user”<sup>39</sup>, Hartley also has not taught or suggested such limitations.

One may argue that Hartley has provided similar teachings because (a) in Hartley’s one-to-one communication Hartley describes “[s]tudents can ask questions of the instructor or tutor ... using the asynchronous methods”<sup>40</sup>, and (b) in Hartley’s one-to-many communication, Hartley describes “students ... can ask questions and have a dialogue that would not otherwise be possible.”<sup>41</sup> These arguments are incorrect since in Hartley, at best it is the students asking questions, but in claim 101(40), it is the computer-implemented method that is asking the question.

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<sup>39</sup> This is acknowledged on pages 6-7 of the Office Action.

<sup>40</sup> The first sentence in the third paragraph on the right-hand column of page 221 of Hartley.

<sup>41</sup> The last sentence in the last full paragraph on the right-hand column of page 221 of Hartley.

Not only is the computer-implemented method asking a user a question during a dialogue session, the method also does not provide the question to at least one other user. Both Goldberg and Harley do not provide such teachings.

Thus, Applicants submit that Goldberg and/or Hartley do not teach or suggest, singly or in any combination, Applicants' claim 101(40).

#### Claim 102(41)

Regarding claim 102(41), though acknowledged as not taught in Goldberg, the Office Action asserted that the limitations are taught in Hartley. First, claim 102(41) depends on claim 101(40). With Hartley not teaching or suggesting claim 101(40), Hartley could not possibly have taught or suggested claim 102(41).

Moreover, it is just not clear where Hartley has taught or suggested that a computer-implemented method retrieving materials related to a subject, during a dialogue session, for at least one of the users, with the materials not provided to at least one other user. In Hartley's one-to-one communication, Hartley generally discusses a student communicating with an instructor, such as through e-mail. This is distinctly different from a computer-implemented method retrieving materials during a dialogue session for a user to work on, let alone the materials retrieved not being provided to at least one other user. Hartley's one-to-many and many-to-many communication do not discriminate who will get the communication.

Thus, Applicants submit that both Goldberg and Hartley, singly or in any combination, do not teach or suggest Applicants' invention as claimed in claim 102(41).

#### Claim 108(47)

Regarding claim 108(47), based on similar discussion under claim 102(41), both Goldberg and Hartley, singly or in any combination, do not teach or suggest, for example, "retrieving materials related to the subject for a user, and not for at least one other user, during the dialogue session", let alone allowing "the user to individually work on the retrieved materials not during the dialogue session".

Moreover, Goldberg and Hartley, singly or in any combination, do not teach or suggest, "allowing a user to transmit materials to one other user, with the materials

available to be received by the one other user, in private, during the session.” In Goldberg’s Chat Tools (which the Office Action acknowledged to be the dialogue session), all occupants of the chat room seem to be able to see what a student types. As to Hartley, it does not teach any private communication among a group of users in its one-to-many and many-to-many communication, let alone all the other limitations in the claim language.

Thus, Applicants submit that Goldberg and/or Hartley do not teach or suggest, singly or in any combination, Applicants’ claim 108(47).

Based on the foregoing, it is submitted that claims 82(21) (with its dependent claims 83(22)-85(24), 87(26)-91(30), 106(45) and 114(53)); 98(37) (with its dependent claim 111(50)); 100(39) (with its dependent claims 102(41)-104(43), and 107(46)); 101(40); and 108(47) (with its dependent claims 109(48) and 113(52)) are patentably distinct over Goldberg in view of Hartley. Thus, it is respectfully requested that the Examiner withdraw the rejections of claims 82(21)-85(24), 87(26)-91(30), 98(37), 100(39)-104(43), 106(45)-109(48), 111(50), 113(52) and 114(53) under 35 U.S.C. 103(a) as obvious over Goldberg in view of Hartley.

#### Paragraph 10 of the Office Action

In its paragraph 10, the Office Action rejected claims 86(25), 92(31)-96(35), 99(38), 105(44), 112(51) and 115(54) under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Hartley and further in view of Howell (U.S. Pat. No. 5,767,897). Applicants respectfully disagree.

The Office Action acknowledged that Goldberg and Hartley do not teach the following<sup>42</sup>, which Applicants agree:

- allowing the face of at least one user to be seen on the screen by other users during the session (as per claim 92 (31));
- the face of another user can be seen on the screen by other users during the session (as per claim 92 (31));

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<sup>42</sup> Page 8, 4<sup>th</sup> line from the bottom to page 9, the 5<sup>th</sup> line of the Office Action.

- during such dialogue, one user can share a drawing with the other users, and changes made in the drawing can be seen by the other users as the changes are made (as per claim 99 (38)); and
- among the some of the users, one user can transmit a drawing to the other users, with the drawing available to be received by the other users, during the separate dialogue (as per claim 112 (51)).

Trying to remedy the deficiency to form the 103 rejection, the Office Action introduced Howell.

First of all, Howell was issued on June 16, 1998, which is after the filing date of the parent application that the current application claims priority to. In any event, Howell does not teach or suggest, singly or in combination with other cited references, Applicants' claimed invention.

Howell pertains to a video conferencing system 10 for a speaker 28 standing in front of a podium 23 to distribute audio and video information to remote sites<sup>43</sup>. The system has a Main-screen mode and a Mark-up mode. "In general then, the purpose of the 'Main-screen' mode is to facilitate podium speaker 28 presentation by enabling him/her to select from, and sequence through, video sources 66-76, or video cameras 14 at sites 12<sub>1</sub>-12<sub>n</sub>, while the 'Mark-up' mode enables the podium speaker 28 to edit, mark-up, annotate, etc., the video provided from a selected one of the video sources 66-76."<sup>44</sup>

Regarding the Main-screen mode, generally speaking, a presentation and preview display areas are simultaneously displayed on a touch screen display 27 for the podium speaker.<sup>45</sup> The presentation display area displays the video information currently viewed by the podium speaker and audience at remote sites. In the presentation area 60, there can be a picture-in-picture mode where the podium speaker 28 can be in a sub-region 53.<sup>46</sup> The preview area is viewable by the podium speaker.<sup>47</sup>

Regarding the Mark-up mode, generally speaking, only the podium speaker is provided with annotation tool icons 140<sub>1</sub>-140<sub>4</sub> to mark-up an image.<sup>48</sup> The podium

<sup>43</sup> The first two full paragraphs in the 3<sup>rd</sup> column and figure 1 of Howell.

<sup>44</sup> Lines 34-40, col. 7, of Howell.

<sup>45</sup> Col. 7, lines 43-45 and lines 53-55, of Howell

<sup>46</sup> Col. 4, line 58 to col. 5, line 8 of Howell.

<sup>47</sup> Col. 6, lines 6-14 of Howell.

<sup>48</sup> Lines 35-36, col. 16 of Howell.

speaker uses the “Hold”/“Go Live” icon 146 to hold an image. This allows the podium speaker 28 to annotate the image, which is distributed to the video monitors 16 at the sites 12<sub>1</sub>-12<sub>n</sub>.<sup>49</sup>

Claim 86(25)

Regarding claim 86(25), first, Howell pertains to a video conferencing system for a speaker standing in front of a podium to distribute audio and video information to remote sites. It is not analogous to a group-learning environment for a group of users to be in a dialogue session to work on and to learn materials related to a subject, as in claim 86(25).

Second, claim 86(25) depends on claim 82(21). With Goldberg and Hartley not teaching or suggesting claim 82(21), even if Howell reads on features in 86(25), Howell could not remedy the deficiencies in Goldberg and Hartley.

Moreover, Howell does not teach or suggest limitations in claim 86(25) where “at least for some of the users, each is represented by a symbol on a screen that can be seen by the other users during the session.”

The only section that the Office Action pointed to in Howell as areas teaching Applicants’ claim 86(25) seem to be the sub-region 53 and the preview area 62 in Howell.<sup>50</sup> If there are other areas in Howell, Applicants respectfully request identifying them as required under 37 C.F.R. 1.104(c)(2).

As to Howell’s sub-region 53, it is incorrect to equate the live image in the sub-region 53 to be the symbol as claimed. The sub-region 53 seems to present a live image of the podium speaker 28<sup>51</sup> as the speaker is presenting. This is distinctly different from representing some of the users (implying at least more than one) in a dialogue session, each by a symbol on a screen that can be seen by the other users during the session, as claimed in claim 86(25).

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<sup>49</sup> The last full paragraph in col. 16 of Howell.

<sup>50</sup> Lines 5-8 in page 9 of the Office Action.

<sup>51</sup> Col. 5, line 6-10; and col. 9, lines 1-6 of Howell.

As to Howell's preview area 62, it is unclear how one can equate the preview area 62 to be the symbol as claimed, when the preview area 62 is an area for viewing by the podium speaker 28<sup>52</sup>.

Thus, Applicants submit that Goldberg, Hartley and Howell, do not teach or suggest, singly or in any combination, claim 86(25).

#### Claim 92(31)

Regarding claim 92(31), with respect to Goldberg and Hartley, as explained above, both of them do not teach or suggest, for example, "allowing a user to share materials generated by the user with other users, with the user's changes in the materials available to be seen by the other users in real time during the session;" and "representing, at least for some of the users, each by a symbol on a screen that can be seen by other users during the session." Also, as acknowledged by the Office Action, both Goldberg and Hartley do not teach "allowing the face of at least one user to be seen on the screen by other users during the session," and "the face of another user can be seen on the screen by other users during the session." Trying to remedy the deficiency, the Office Action introduced Howell.

As explained above, Howell pertains to a video conferencing system for a speaker to distribute audio and video information to remote sites. It is not analogous to a group-learning environment for a group of users to start a dialogue session to work on and to learn about materials related to a subject. One may argue that in Howell, the audience in remote sites may be working on a subject. Even if such an argument is applicable, Howell does not provide them with an interactive environment to help them learn, let alone through a plurality of electronic devices, each being able to at least receive inputs from a user. With no such session, they could not share materials generated by one with the others in real time during the session; have materials retrieved for each of them during the session; and perform or experience other limitations as claimed that occur during the session, such as representing some of the users, each by a symbol on a screen that can be seen by other users during the session.

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<sup>52</sup> Col. 6, lines 6-14 of Howell.

Thus, Applicants submit that Goldberg, Hartley and Howell, do not teach or suggest, singly or in any combination, claim 92(31).

#### Claim 99(38)

Regarding claim 99(38), with respect to Goldberg and Hartley, as explained above, both references do not teach or suggest, for example, “retrieving materials related to the subject for a user during the session; and allowing the user to individually work on the retrieved materials not during the dialogue session, wherein the method further comprises retrieving materials related to the subject for another user, with the materials tailored to the another user, such that the materials retrieved can be different for a different user.” It is not clear, for example, where Goldberg or Hartley teaches or suggests retrieving materials that are tailored to a user. Nowhere has Howell taught or suggested such features also.

The Office Action acknowledged that both Goldberg and Hartley do not teach the limitations of “during such dialogue, one user can share a drawing with the other users, and changes made in the drawing can be seen by the other users as the changes are made.”

To try to remedy this deficiency, the Office Action introduced Howell. As explained above, Howell does not teach or suggest allowing a group of users to engage in a dialogue session while working on the subject, through at least a plurality of electronic devices, each being able to at least receive inputs from a user. Howell provides no such dialogue session, let alone allowing – during the dialogue session -- one of the users to share a drawing with the other users, with changes made in the drawing being able to be seen by the other users as the changes are made.

Thus, Applicants submit that Goldberg, Hartley and Howell, do not teach or suggest, singly or in any combination, claim 99(38).

#### Claim 112(51)

Regarding claim 112(51), first, claim 112(51) depends on claims 100(39) and 107(46). With Goldberg and Hartley not teaching or suggesting claims 100(39) and



107(46), even if Howell reads on features in 112(51), Howell could not remedy the deficiencies in Goldberg and Hartley.

Moreover, Howell does not teach or suggest limitations in claim 112(51). As recited in claim 100(39), “some of the users” can be more than two, and they are a part of a group of users working on and learning about a subject in a dialogue session. The method in claim 112(51) allows the “some of the users” to be engaged in a separate dialogue privately among themselves. As explained above, Howell does not teach or suggest a dialogue session for a group of users to work on and to learn a subject, let alone a separate dialogue among the group of users, or one of them being able to transmit a drawing to the others, with the drawing available to be received by the other users, during the separate dialogue.

Thus, Applicants submit that Goldberg, Hartley and Howell, do not teach or suggest, singly or in any combination, claim 112(51).

Based on the foregoing, it is submitted that claim 86(25) (with its dependent claim 105(44)), claim 92(31) (with its dependent claims 93(32)-96(35)), claim 99(38) (with its dependent claim 115(54)) and claim 112(51) are patentably distinct over Goldberg in view of both Hartley and Howell. Thus, it is respectfully requested that the Examiner withdraw the rejection of claims 86(25), 92(31)-96(35), 99(38), 105(44), 112(51) and 115(54) under 35 U.S.C. 103(a) as obvious over Goldberg in view of both Hartley and Howell.

As to the newly added claim 55, it is patentably distinct from Goldberg, Hartley and/or Howell, because, for example, they do not teach or suggest, singly or in any combination, monitoring at least one user's inputs during the dialogue session so as to have the monitored inputs available for analysis to determine if the user has been distracted from the subject.

Regarding the remaining references cited by the Examiner, since they have not been applied against any of the claims and do not appear properly applicable thereto, no further mention thereof will be made.

In conclusion, it is submitted that all of the pending claims 82(21) through 115(54) and claim 55 are patentably distinct from the cited references. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from the cited references. Applicants respectfully request that the Examiner withdraw his rejections of claims 82(21) – 115(54). Reconsideration of the application and an early Notice of Allowance for claims 82(21) – 115(54) and claim 55 are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

Any required fee in connection with the filing of this response is to be charged to Deposit Account No. 50-0727.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Tong", with a stylized flourish at the end.

By Peter Tong  
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